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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/247,502

Applicant(s)

BATES ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-31 and 33-36 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1 – 9, 11 – 22 and 25 – 36 are presented for examination.

#### ***Allowable Subject Matter***

1. The following is a statement of reasons for the indication of allowable subject matter:  
The limitation of claim 19 states, “wherein notifying the first user of the association of the second hypertext document with the second user includes displaying the list of favorite links to the first user, and wherein the method further comprising building a list of favorite links associated with the hypertext document being viewed by the first user by combining lists of favorite links associated with only those users currently viewing the same hypertext document as the first user,” is unique and different from the prior art that was previously stated.

#### ***Claim Objections***

2. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections - 35 USC § 103***

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3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 5 – 8, 13 – 18, 20 – 22, 25 – 31 and 33 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton et al. (6020884) (hereinafter MacNaughton) in view of Suzuki et al. (6240443) (hereinafter Suzuki).

5. As per claim 1, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

6. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line 57);

7. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line 57); but does not specifically teach

8. (c) maintaining on behalf of the first user a saved user list that identifies at least the second user such that the first user is notified of the identity of any user in the saved user list that is accessing the same hypertext document, wherein maintaining the saved user list includes at least one of adding a third user to the saved user list and removing the second user from the saved user list in response to user input received from the first user. Suzuki teaches maintaining on behalf of the first user a saved user list that identifies at least the second user such that the first user is notified of the identity of any user in the saved user list that is accessing the same hypertext document, wherein maintaining the saved user list includes at least one of adding a

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third user to the saved user list and removing the second user from the saved user list in response to user input received from the first user, (e.g. col. 7, lines 14 – 42 & col. 9, lines 64 – 67). It would have been obvious to one of ordinary skill in the art to combine Suzuki with MacNaughton because it would be more efficient if the first user could edit their list so to add new users that could contribute to his internet activities, i.e. new friend to chat with, and to get delete users that are no longer using the same system as the first user, therefore, aiding in keeping an updated list.

9. As per claim 2, MacNaughton teaches tracking accesses to the plurality of preexisting hypertext document includes maintaining a list of users that access each hypertext document, and wherein notifying the first user includes notifying the first user of the identity of each user in the list of users, (e.g. col. 7, line 57 – col. 8, line 57).

10. As per claim 5, MacNaughton teaches tracking accesses to the hypertext document further includes removing from the list of users a user that is no longer accessing the hypertext document, (e.g. col. 9, lines 5 – 24).

11. As per claim 6, MacNaughton teaches wherein the second user has a home hypertext document associated therewith, the method further comprising communicating to the first user a copy of the home hypertext document associated with the second user in response to user input from the first user, (e.g. col. 7, line 57 – col. 8, line 57).

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12. As per claim 7, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

13. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line 57);

14. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, wherein the second user is identified in a saved user list for the first user, (e.g. col. 7, line 57 – col. 8, line 57); but does not specifically teach

15. (c) notifying the first user of the location of another hypertext document currently being viewed by a third user, wherein the third user is identified in the saved user list for the first user; and

16. (d) managing the saved user list for the first user in response to user input from the first user, including at least one of adding and removing users to and from the saved user list. Suzuki teaches notifying the first user of the location of another hypertext document currently being viewed by a third user, wherein the third user is identified in the saved user list for the first user, (e.g. col. 9, line 23 – col. 10, line 34); and

17. (d) managing the saved user list for the first user in response to user input from the first user, including at least one of adding and removing users to and from the saved user list, (e.g. col. 9, line 23 – col. 10, line 34). It would have been obvious to one of ordinary skill in the art to combine Suzuki with MacNaughton because if the first user desired to change users to communicate with and/or view a different topic that interests the first user it would be more convenient to be able to view other users that would be in different hypertext documents.

18. As per claim 8, MacNaughton teaches communicating to the first user a copy of the hypertext document currently being viewed by the third user, (e.g. col. 7, line 57 – col. 8, line 57).

19. As per claim 13, MacNaughton teaches wherein notifying the first user of the identity of the second user includes notifying the first user of whether the second user is currently active in the multi-user computer environment, (e.g. col. 21, lines 4 – 24).

20. As per claim 14, MacNaughton teaches performing a predetermined list management operation on the user list in response to user input from the first user, the predetermined list management operation selected from the group consisting of sending a message to a user in the user list, navigating to a hypertext document currently being viewed by a user from the user list, and navigating to a home hypertext document for a user from the user list, (e.g. col. 9, lines 6 – 52).

21. As per claim 15, MacNaughton teaches

22. (a) associating a second hypertext document with the second user in response to user input from the second user, (e.g. col. 9, lines 6 – 52); and

23. (b) notifying the first user of the association of the second hypertext document with the second user, (e.g. col. 9, lines 6 – 52).

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24. As per claim 16, MacNaughton teaches communicating the second hypertext document to the first user in response to user input from the first user, (e.g. col. 7, line 57 – col. 8, line 57).

25. As per claim 17, MacNaughton teaches associating the second hypertext document with the second user includes storing an identifier for the second hypertext document in a list of favorite links associated with the second user, and wherein notifying the first user of the association of the second hypertext document with the second user includes displaying the list of favorite links to the first user, (e.g. col. 7, line 57 – col. 8, line 57).

26. As per claim 18, MacNaughton teaches displaying the list of favorite links is performed responsive to user input received from the first user while the first and second users are currently viewing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line 57).

27. As per claim 20, MacNaughton teaches

28. (a) associating a second hypertext document with a first hypertext document in response to user input from the second user, (e.g. col. 7, line 57 – col. 8, line 57); and

29. (b) notifying the first user of the association of the second hypertext document with the first hypertext document, (e.g. col. 7, line 57 – col. 8, line 57).

30. As per claim 21, MacNaughton teaches associating the second hypertext document with the first hypertext document includes temporarily associating the second hypertext document with the first hypertext document such that the association therebetween is discarded whenever



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the second user is not active in the multi-user computer environment, (e.g. col. 7, line 57 – col. 8, line 57).

31. As per claim 22, MacNaughton teaches tracking accesses to the plurality of preexisting hypertext documents is performed in a first computer, and wherein at least a portion of the plurality of preexisting hypertext documents are stored externally from the multi-user computer environment, (e.g. col. 7, line 57 – col. 8, line 57).

32. As per claim 25, MacNaughton teaches an apparatus, comprising:

33. a memory, (e.g. col. 21, lines 10 – 25); and

34. a program, resident in the memory, the program configured to track accesses to a plurality of preexisting documents by a plurality of users, to notify a first user among the plurality of users that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user among the plurality of users that is accessing the same hypertext document(e.g. col. 6, lines 1 – 12), and to maintain on behalf of the first user a saved user list that identifies at least the second user such that the first user is notified of the identify of any user in the saved user list that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line 57 & col. 9, line 53 – col. 10, line 35), but does not specifically teach wherein the program is configured to maintain the saved user list by performing at least one of adding a third user to the saved user list and removing the second user from the saved user list in response to user input received from the first user. Suzuki teaches wherein the program is configured to maintain the saved user list by performing at least one of adding a third user to the saved user list

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and removing the second user from the saved user list in response to user input received from the first user, (e.g. col. 7, lines 32 – 63 & col. 9, line 23 – col. 10, line 34). It would have been obvious to one of ordinary skill in the art to combine Suzuki with MacNaughton because it would be more efficient if the first user could edit their list so to add new users that could contribute to his internet activities, i.e. new friend to chat with, and to get delete users that are no longer using the same system as the first user, therefore, aiding in keeping an updated list.

35. As per claim 26, MacNaughton teaches the program is further configured to maintain a list of users that access each hypertext document, and to notify the first user of the identity of each user in the list of users, (e.g. col. 7, line 57 – col. 8, line 57).

36. As per claim 27, MacNaughton teaches the second user has a home hypertext document associated therewith, the program further configured to communicate to the first user a copy of the home hypertext document associated with the second user in response to user input from the first user, (e.g. col. 8, line 58 – col. 9, line 52).

37. As per claim 28, MacNaughton teaches the program is further configured to retrieve a navigation history for the second user, the navigation history including a set of hypertext documents previously accessed by the second user, (e.g. col. 8, lines 10 – 57).

38. As per claim 29, MacNaughton teaches the memory is disposed in a server computer, the apparatus further comprising a client computer coupled to the server computer, (e.g. col. 21, line

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52 – col. 22, line 14), the client computer including a second memory and a second program resident in the second memory, the second program configured to display a first hypertext document to the first user, the first hypertext document including a hypertext link to a second hypertext document that is in the navigation history for the second user, the second program further configured to display within the first hypertext document an indication that the second hypertext document is in the navigation history for the second user, (e.g. col. 3, line 41 – col. 4, line 27).

39. As per claim 30, MacNaughton teaches the program is further configured to associate a second hypertext document with the second user in response to user input from the second user, (e.g. col. 7, line 57 – col. 8, line 57); and to notify the first user of the association of the second hypertext document with the second user, (e.g. col. 7, line 57 – col. 8, line 57).

40. As per claim 31, MacNaughton teaches the program is further configured to store an identifier for the second hypertext document in a list of favorite links associated with the second user, (e.g. col. 7, line 57 – col. 8, line 57).

41. As per claim 33, MacNaughton teaches the program is further configured to associate a second hypertext document with a first hypertext document in response to user input from the second user, and to notify the first user of the association of the second hypertext document with the first hypertext document, (e.g. col. 7, line 57 – col. 8, line 57).

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42. As per claim 34, MacNaughton teaches the program is further configured to temporarily associate the second hypertext document with the first hypertext document such that the association therebetween is discarded whenever the second user is not active, (e.g. col. 7, line 57 – col. 8, line 57).

43. As per claim 35, MacNaughton teaches further comprising a first computer within which the memory is disposed, wherein the program is configured to retrieve at least a portion of the plurality of preexisting hypertext documents from a second computer remote from the first computer and external from the apparatus, (e.g. col. 7, line 57 – col. 8, line 57).

44. As per claim 36, MacNaughton teaches the second computer is coupled to the first computer over the Internet, (e.g. col. 7, line 57 – col. 8, line 57).

45. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton (6020884) in view of Suzuki (6240443) in further view of, “Chat Comp: Lobby”, Yahoo!, <http://chat.yahoo.com>, downloaded 11/18/98, (hereinafter Yahoo).

46. As per claim 3, MacNaughton and Suzuki do not specifically teach notifying the first user of the identity of each user in the list of users includes displaying the list of users to the first user. Yahoo teaches notifying the first user of the identity of each user in the list of users includes displaying the list of users to the first user, (Yahoo page 2). It would have been obvious to one skilled in the art at the time the invention was made to combine Yahoo with the combine system

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of MacNaughton and Suzuki because it is easier and more pleasing to the eye to see a user on a list on a Web page then in a database.

47. As per claim 4, MacNaughton and Suzuki do not teach notifying the first user of the identity of each user in the list of users includes separately notifying the first user of each user from the list of users that is no longer accessing the hypertext document. Yahoo page 1 and Yahoo page 2 teaches notifying the first user of the identity of each user in the list of users includes separately notifying the first user of each user from the list of users that is no longer accessing the hypertext document. It would have been obvious to one skilled in the art at the time the invention was made to combine Yahoo with the combine system of MacNaughton and Suzuki because the first user would not have to search for a user to find out if the second user is accessing the hypertext document. The first user would only need to look at the updated list.

48. Claims 9, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton (6020884) in view of Kavner (6366947).

49. As per claim 9, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

50. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line 57);

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51. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line 57),

52. wherein tracking accesses to the hypertext document further includes maintaining a table for the second user, the table including a set of hypertext documents previously accessed by the second user, and wherein the method further comprises notifying the first user of the set of hypertext documents in the table for the second user, (e.g. col. 7, line 57 – col. 8, line 57).

MacNaughton does not specifically teach a table of navigation history. Kavner teaches a table of navigation history, (e.g. col. 5, line 53 – col. 6, line 6 & col. 17, lines 3 – 30). It would have been obvious to one skilled in the art at the time the invention was made to combine Kavner with MacNaughton because it would be more convenient for users viewing the same web page to view other user's web navigation history that might have view other web sites that pertain to or similar to a topic of a web site that all of the users are viewing or trying to locate. Furthermore, the history of the pages previously accessed could be preloaded to the user as a way to provide a faster load time because it is predicted that the user would likely view the previously accessed web pages when they pertain to the same information currently being view by the user or users.

53. As per claim 12, MacNaughton teaches displaying the indication includes displaying the hypertext link to the second hypertext document in a color associated with the second user, (e.g. col. 8, line 58 – col. 9, line 5).

54. Claim 11 is rejected for similar reasons as stated above.

*Response to Arguments*

55. Applicant's arguments with respect to claims 1 – 9, 11 – 22 and 25 – 36 have been considered but are moot in view of the new ground(s) of rejection.

56. In the remarks, Applicant argues in substance that the reference of MacNaughton does not teach or disclose the limitations of claim 19, more specifically the concept of displaying a list of favorite links to a first user, where the list of favorite links is built by combining lists of favorite links associated with only those users currently viewing the same hypertext document as the first user.

57. As to part 1, the Examiner agrees with the Applicant and understands the interpretation of the Applicant's invention and how it pertains and over comes the prior art.

58. In the remarks, Applicant argues in substance that the reference of Suzuki does not teach the limitations of claim 1, in particular, providing the ability for a user to maintain a personalized user list that is user-editable.

59. As to part 2, Examiner would like to draw the Applicant's attention to the claim language of claim 1, stating, "maintaining on behalf of the first user a saved user list that identifies at least the second user such that the first user is notified of the identity of any user in the saved user list

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that is accessing the same hypertext document, wherein maintaining the saved user list includes at least one of adding a third user to the saved user list and removing the second user from the saved user list in response to user input received from the first user.”

60. In this section the Applicant states that “the first user is notified of the identity or any user in the saved user list that is accessing the same hypertext document,” which is taught by Suzuki as restated and clarified above, (e.g. col. 7, lines 14 – 47, “...*makes a user list 104 which is a list of user terminals connected to the same URLs...*”). The second part discloses adding and removing users from a list in response to user input received from the first user. There is no discloser about a “user-editable” list. An input from a first user could be entering a different URL where the second user is not currently viewing but a third user is viewing. Therefore, from the user selecting a different URL to view the second user is deleted from the list and the third user is added to the list. Suzuki teaches this in column 7, lines 14 – 42 and column 9, lines 64 – 67. If the Applicant were to be more specific about a “user-editable” list, this would possibly overcome the prior art but would require further search and consideration. Claims 7 and 25 are also maintained for similar reasons as stated above and as stated the similarities of claim 1 and 25 by the Applicant.

61. In the remarks, Applicant argues in substance that the references of MacNaughton and Konno are not obvious to one of ordinary skill in the art and that there is not mention of why or how to combine these references.



62. As to part 3, Examiner has stated a different art for the claims that MacNaughton and Konno where teaching, claims 9, 11 and 12. Therefore, argument is moot in new grounds of rejection.

***Conclusion***

63. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

64. a. Perkowitz et al. U.S. Patent No. 6138128 Sharing and organizing world wide web references using distinctive characters.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is none.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England  
Examiner  
Art Unit 2143

De



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100